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10/804,600	03/18/2004	Mikko Lonnfors	P3647US01	9543

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DITTHAVONG MORI & STEINER, P.C.
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EXAMINER
BLAIR, DOUGLAS B

ART UNIT	PAPER NUMBER
2442	

NOTIFICATION DATE	DELIVERY MODE
12/22/2010	ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☒ Responsive to communication(s) filed on *29 September 2010*.

2a) ☐ This action is **FINAL**.   2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) *1,3-17 and 19-32* is/are pending in the application.

    4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) *1,3-17 and 19-32* is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

    a) ☐ All   b) ☐ Some * c) ☐ None of:

      1. ☐ Certified copies of the priority documents have been received.

      2. ☐ Certified copies of the priority documents have been received in Application No. _____.

      3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

    * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)

2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
    Paper No(s)/Mail Date _____.

4) ☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .

5) ☐ Notice of Informal Patent Application

6) ☐ Other: _____ .

DETAILED ACTION

Response to Amendment

In view of the Appeal Brief filed on 9/29/2010, PROSECUTION IS HEREBY

REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following

two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37

CFR 1.113 (if this Office action is final); or,

(2) initiate a new appeal by filing a notice of appeal under 37 CFR 41.31 followed by an

appeal brief under 37 CFR 41.37. The previously paid notice of appeal fee and appeal brief fee

can be applied to the new appeal. If, however, the appeal fees set forth in 37 CFR 41.20 have

been increased since they were previously paid, then appellant must pay the difference between

the increased fees and the amount previously paid.

A Supervisory Patent Examiner (SPE) has approved of reopening prosecution by signing

below:

/John Follansbee/

Supervisory Patent Examiner, Art Unit 2451

Response to Arguments

Applicant's arguments with respect to claims 1, 3-6, 8-16, and 19-32 have been

considered but are moot in view of the new ground(s) of rejection. The rejections have been

substantially revised and therefore the applicant's specific arguments are not applicable.

The applicant's argument with respect to claim 7 is persuasive.

With respect to the applicant's argument A, a new rejection is presented based on 35 USC

section 112 1st paragraph because the applicant's claims and arguments are not consistent with

the applicant's disclosure.

With respect to the applicant's argument B, the Examiner recommends that the applicant

amend to the claims to specify that only information which is changed is transmitted. Such an

amendment would overcome the current rejections but further search and consideration would be

necessary to determine the patentability of such a limitation. Currently the claims state that the

changed information is transmitted but does not preclude a system in which all information is

transmitted from reading on the claims. If all information is transmitted, then the changed

information is also transmitted.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1, 3-16, and 19-32 are rejected under 35 U.S.C. 112, first paragraph, as failing to

comply with the written description requirement. The claim(s) contains subject matter which

was not described in the specification in such a way as to reasonably convey to one skilled in the

relevant art that the inventor(s), at the time the application was filed, had possession of the

claimed invention. .

The applicant is claiming, in claim 1, a presence document which comprises a plurality of parameters relating to the presentity, the parameters including the presence information. In the applicant's Summary Section of the Appeal Brief, the applicant cited paragraphs 34 and 55-62 (It is assumed that the applicant was referring to the paragraph numbers in the published patent application, 2004/0177134 because the applicant's specification does not have paragraph numbers) as providing support for this claim feature. The applicant's specification only describes one parameter; a version parameter. The cited portions of the applicant's specification clearly make a distinction between elements, attributes, and parameters so when the applicant is claiming parameters it is assumed that the applicant is not intending to refer to the disclosed elements and attributes.

Because there is only one parameter disclosed by the applicant, the applicant's specification does not support "a plurality of parameters relating to the presentity". The applicant's specification also does not support the language "the parameters including the presence information" because the parameters disclosed by the applicant's are only versions of presence documents and not actual presence information. Claims 3-16 are rejected by virtue of their dependence on claim 1. Claim 19-32 feature the same issues as claims 1 and 3-16.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1, 3-17, and 19-32 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The preamble of claim 1 does not make sense. The preamble states, "a computer-readable storage medium having instructions stored thereon which are executable by a computer system by performing steps comprising:". This language implies that the claimed steps cause the claimed instructions to be executed. It is assumed the applicant is trying to claim a scenario in which the claimed instructions, when executing, perform the claimed steps. The preamble of claim 17 features the same problem as that of claim 1.

Claim 1 recites the limitation "the presence information" in the fifth line of the claim. There is insufficient antecedent basis for this limitation in the claim. Claim 1 does not previously mention any presence information.

Claim 1 also seems to be missing words in the final limitation of the claim. The limitation reads, "causing, at least in part, transmission of the presence document the partial presence information that has changed to a terminal requesting the presence information." It is unclear whether the presence document, the partial presence information, or both are being transmitted according to this claim language.

Claim 10 recites the limitation "the instructions executable by the computer system further comprise" in the first two lines of claim 10. There is insufficient antecedent basis for this limitation in the claim. Specifically, claim 1 does not state what the instructions comprise, only what the do when executed, so the instructions in claim 10 cannot **further** comprise anything.

Claim 14 features the same problem as claim 10.

Claims 3-16 are all unclear by virtue of their dependence on claim 1.

The language of claim 17 is ambiguous. It is not clear whether the claimed actions of "creating at least one tuple", "associating presence information", "sending the presence

document", "comparing the version value", and "directing the client terminal" are part of the

claimed action of "creating a presence document" or are intended to be the steps referred to in the

preamble.

Claim 19 recites the limitation "the partial presence information" in the final line of the

claim. There is insufficient antecedent basis for this limitation in the claim. There is no "partial

presence information" previously referred to anywhere in claim 19.

Claims 20-30 are rejected by virtue of their dependence on claim 19

Claim 31 recites the limitation "the partial change information" in the final line of the

claim. There is insufficient antecedent basis for this limitation in the claim. There is no "partial

change information" previously referred to anywhere in claim 31.

Claim 32 recites the limitation "the partial presence information" in the third to last line

of the claim. There is insufficient antecedent basis for this limitation in the claim. There is no

"partial presence information" previously referred to anywhere in claim 32.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or
> any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and
> requirements of this title.

Claims 1 and 3-17 are rejected under 35 U.S.C. 101 because the claimed invention is

directed to non-statutory subject matter. Claims 1 and 3-17 are directed towards computer

readable storage mediums. The applicant's specification does not provide a limiting definition of

what a computer readable storage medium comprises. Therefore the claimed term can be

interpreted broadly to cover transitory mediums. Transitory mediums do not fit into any of the

statutory categories of invention.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in
> section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are
> such that the subject matter as a whole would have been obvious at the time the invention was made to a person
> having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the
> manner in which the invention was made.

Claims 1, 3-6, 8, 10-16, and 19-32 are rejected under 35 U.S.C. 103(a) as being

unpatentable over U.S. Patent Application Publication Number 2002/0129103 by Birkler in view

of U.S. Patent Number 6,658,095 to Yoakum et al.

As to claim 1, Birkler teaches a medium with instructions which when executed perform

steps comprising: creating a presence document corresponding to a presentity and specifying a

version of the presence document **(paragraph 20)**, wherein the presence document comprises a

plurality of parameters relating to the presentity, the parameters including the presence

information **(paragraph 3, shows the various parameters which define the presence**

information); and causing, at least in part, transmission of the presence document and/or partial

presence information that has changed to a terminal requesting the presence information **(Birkler**

transmits all information for the new version of the presence document, including the

information which has changed. The applicant has not limited the information to that

which has changed.); However Birkler does not explicitly teach a determination of partial

presence information as a portion of the presence information available for the presentity.

Yoakum teaches a method of determining partial presence information as a portion of the presence information available for the presentity **(col. 7, lines 30-35, the different views are partial presence information)**.

It would have been obvious to one of ordinary skill in the Information Technology art at the time of the invention to combine the teachings of Birkler regarding providing versions for presence documents with the teachings of Yoakum regarding the determination of partial presence information because the subscribers may only wish to receive certain types of information (Yoakum, col. 4, lines 63-67).

As to claim 3, the Birkler-Yoakum combination teaches the method of claim 1, however the Birkler-Yoakum combination teaches does not explicitly teach instructions for providing a mode value in the presence information indicative of whether the presence document includes the partial presence information or the complete presence information.

Yoakum teaches both the provision of partial and complete presence information and therefore implicitly teaches a mode value.

It would have been obvious to one of ordinary skill in the Computer Networking art at the time of the invention to combine the teachings of the Birkler-Yoakum combination teaches regarding complete and partial presence information with the concept of a mode value because providing a mode value would make it clear to the user the type of information that they are otherwise already receiving.

As to claim 4, Yoakum teaches instructions for providing at least one action value in the presence information (col. 9, lines 4-20).

As to claim 5, the Yoakum-Davies combination does not explicitly teach the use of CPIM

PIDF. Official Notice is taken that CPIM PIDF was a well known format for storing presence

information, such as that taught by the Birkler-Yoakum combination, at the time of the

applicant's invention. It would have been obvious to one of ordinary skill in the Computer

Networking art at the time of the invention to combine the teachings of the Yoakum-Davies

combination regarding presence information with CPIM PIDF because CPIM PIDF provides a

specific implementation for the teachings of the Birkler-Yoakum combination that were

discussed generically and combining the concepts would produce a predictable result.

As to claims 6 and 8, see paragraphs 20-23 of Birkler.

As to claim 10-14, Yoakum teaches instructions for facilitating terminal subscriptions,

fetching and polling, providing notifications and providing indications of changes (See col. 9-

12).

As to claim 15, Birkler teaches providing a presence document according to

predetermined time intervals (See Abstract).

As to claim 16, Yoakum teaches instructions for providing a predefined attribute value

with the partial presence information (col. 9, lines 4-20).

Claim 19 is rejected according to the embodiments cited in the rejection of claim 1.

As to claim 20, Yoakum teaches a UE terminal as in claim 19, wherein the watcher

application is executable by the processor to generate the at least one request in the form of

subscription request to subscribe to the presence information of the at least one presentity (**col.

10, lines 11-16**).

As to claim 21, Yoakum teaches a UE terminal as in claim 20, wherein the subscription request comprises a SIP SUBSRIBE method **(col. 10, lines 11-16)**.

As to claim 23, Yoakum teaches a UE terminal as in claim 19, wherein the watcher application is executable to receive partial presence information by fetching the partial presence information **(col. 9, lines 4-20)**.

As to claim 24, Yoakum teaches a UE terminal as in claim 19, wherein the watcher application is executable by the processor to receive the partial presence information via a partial presence notification identifying the less than the totality of the presence information available for the at least one presentity **(col. 3, lines 47-61)**.

As to claim 25, Yoakum teaches a UE terminal as in claim 19, wherein the watcher application is executable by the processor to receive the partial presence information in the form of a notification message to provide the watcher application with the partial presence information **(col. 12, lines 10-35)**.

As to claim 26, Yoakum teaches the UE terminal as in claim 25, wherein the notification message comprises a SIP Notify method **(col. 12 lines 10-35)**.

As to claim 27, Yoakum teaches the UE terminal as in claim 19, further comprising a transceiver capable of transmitting the at least one request, and of receiving the partial presence information, via a network **(See Background)**.

As to claims 28-30, Yoakum teaches wireless data transfers via mobile phones and the devices claimed in claim 30 **(See Background)**.

Claims 31 and 32 are rejected according to the embodiments cited in the rejection of

claim 1.

Allowable Subject Matter

Claim 7 and 9 are objected to as being dependent upon a rejected base claim, but would

be allowable if rewritten in independent form including all of the limitations of the base claim

and any intervening claims.

Claim 17 is allowable over the prior art of record but rejected under 35 USC sections 101

and 112.

As allowable subject matter has been indicated, applicant's reply must either comply with

all formal requirements or specifically traverse each requirement not complied with. See 37

CFR 1.111(b) and MPEP § 707.07(a).

The following is a statement of reasons for the indication of allowable subject matter: In

claim 17, the applicant claims a medium implementing a method which at the client terminal,

compares the version value of presence information with a previously stored version value of

presence information in order to update the presence information at the client terminal. U.S.

Patent Number 6,658,095 to Yoakum teaches the concept of providing partial presence

information (as shown in the rejection of claim 1 in this action) but Yoakum does not teach the

claimed concept of associating the tuple including a version value with the presence information.

U.S. Patent Application Publication Number 2002/0129103 by Birkler teaches the idea of

associating a version number with presence information for comparison purposes (paragraphs

20-23) however Birkler makes the comparison of version numbers at the server and not at the

client terminal as claimed. None of the other prior art of record was found to anticipate or make obvious the subject matter of claim 17. Claim 9 is allowable for the same reason as claim 17. Claim 7 is allowable over the prior art for the reasons argued by the applicant in the Appeal Brief.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to DOUGLAS B. BLAIR whose telephone number is (571)272-3893. The examiner can normally be reached on 9:00am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (571) 272-3949. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Douglas B Blair/

Primary Examiner, Art Unit 2442